

retaining means for retaining a reinforcement member to a retaining wall, said retaining means being integrally formed in said wall block, said retaining means including a non-vertical, inwardly extending surface.

D³
14. (Twice amended) The wall block of claim 12, wherein said channel is defined by a front wall, rear wall and a channel bottom surface, said rear wall including [an] said inwardly extending shoulder.

Please add the following *new* claims:

D⁴
18. (Newly added) The method of claim 17, wherein the channel has at least one inwardly extending shoulder that serves to retain the reinforcement member within the channel.

D⁵ 19. (Newly added) The method of claim 18, wherein the at least one inwardly extending shoulder is formed with a curved lip.

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed October 4, 2000. Claims 1-17 remain under consideration in the present application. Of these, claims 11 and 14 have been amended with this response. In addition, new claims 18 and 19 have been added with this response. It is believed that the foregoing amendments and additions present no new matter to the instant application. Reconsideration and allowance of the presently pending claims under consideration is respectfully requested. Each objection and rejection presented in the Office



Action is discussed in the remarks that follow.

A. Abstract Objections

The abstract of the disclosure has been objected to because of the inclusion of improper terms. Through this response, the abstract has been amended to remove all such language.

B. Claim Objections

Claim 11 has been objected under to for an informality. This claim has been amended in the manner suggested by the Examiner to correct this informality.

C. Claim Rejections - 35 U.S.C. § 102(e)

1. Statement of the Rejection

Claim 17 has been rejected under 35 U.S.C. § 102(e) as being anticipated by Dawson (U.S. Pat. No. 5,865,006).

The rejection states that Dawson discloses applicant's invention as recited in claim 17, including the step of "securing at least one reinforcement member to the wall with a retaining bar that overlaps the reinforcement member within the channel". Applicant respectfully traverses this rejection.

2. Applicant's Claimed Invention

Applicant's claim 17 describes a method for forming a segmental retaining wall. As provided in this claim, applicant claims:

17. A method for forming a segmental retaining wall, said method comprising the steps of:

stacking a plurality of wall blocks in aligned courses, a plurality of said wall blocks having a channel formed therein; and

securing at least one reinforcement member to the wall with a retaining bar that overlaps the reinforcement member within the channel;

wherein the retaining bar secures the reinforcement member to the wall when tensile forces are imposed upon the reinforcement member.

Applicant's claim 17 (emphasis added).

3. The Dawson Reference

Dawson discloses retaining wall and block configurations. The blocks 1 include removable flanges 8 that include a plurality of pin apertures 12 that extend perpendicularly through the flanges and into the block bodies. The flanges of the blocks are used to align the courses of the wall (*see* column 5, lines 29-33). Accordingly, the blocks are stacked such that the flange of upper adjacent blocks abut lower adjacent blocks (*see* Fig. 11). Alternatively, the flanges can be removed and pins 16 can be provided in the pin apertures 12 to align the blocks (*see* column 5, lines 29-33). Accordingly, the blocks can be stacked such that the pins of upper adjacent blocks abut lower adjacent blocks (*see* Fig. 16)

As described in column 6, lines 48-65, a wall is constructed with the blocks by stacking the blocks in aligned courses with the aid of the flanges and placing backfill behind the blocks. Upon reaching a desired height, a geogrid 31 can be laid over the top course and the backfill. The removable flanges of the blocks that will be used to form the next course are broken off, and pins

16 inserted into the pin apertures of these blocks. Next, the pinned blocks are placed over the top course and geogrid such that the pins extend through apertures of the geogrid and engage the back surface of the blocks of the top course (*see* Fig. 16). Notably, although the pins extend through the geogrid, *these pins are not provided to retain the geogrid*. The pins merely provide means for aligning adjacent courses while still permitting the geogrid to be placed between the blocks. Thereafter, wall construction continues in the same manner until the desired wall height has been achieved.

4. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of *each element* of the claim under consideration." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Dawson reference. Most notably, Dawson clearly does not anticipate "securing at least one reinforcement member to the wall with a retaining bar that overlaps the reinforcement member within the channel" as is required by applicant's claim 17. The rejection alleges that Dawson teaches securing the reinforcement member (*i.e.*, geogrid 31) to the wall with a "retaining bar (16) that overlaps the reinforcement member within the channel." As described above, however, the so-called "retaining bar" (*i.e.*, pin 16) of Dawson does *not* retain the reinforcement member as does

applicant's retaining bar. Instead, the pins 16 are placed in the pin apertures 12 to align the blocks (*see* column 5, lines 29-33).

In addition to not serving any retaining function for the geogrid, not one of Dawson's pins "overlaps the reinforcement member within the channel". First, Dawson's pins are not used in any channels. Instead, they fit within pin-shaped apertures 12 (*see e.g.*, Fig. 4). Furthermore, as is shown in Fig. 16, the geogrid does not (and indeed cannot) be placed within these apertures so that the pins overlaps the geogrid *within* the apertures. Again, Dawson expressly identifies that the pins *pass through* apertures in the geogrid (*see* column 6, lines 56-59).

Due to these clear shortcomings of the Dawson reference, applicant respectfully asserts that Dawson does not anticipate claim 17. Therefore, applicant respectfully requests that the rejection of this claim be withdrawn.

D. Claim Rejections - 35 U.S.C. § 103(a)

1. Rejection of Claims 1-7 and 10-16

a) Statement of the Rejection

Claims 1-7 and 10-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainey (U.S. Pat. No. 5,921,715).

The rejection alleges that Rainey discloses applicant's invention substantially as claimed with the exception of front and rear shoulders on front and rear channel walls. The rejection concludes, however, that it would have been obvious to a person having ordinary skill in the art to provide such shoulders. Applicant respectfully traverses this rejection.

b) Applicant's Claimed Invention

Applicant's claims 1-7 and 10-16 describe a retaining wall system and block. As provided in applicant's independent claims 1 and 11, for example, applicant claims:

1. A wall block for use in a segmental retaining wall system, said wall block comprising:
 - an interior face for forming an interior surface of a segmental retaining wall;
 - an exterior face for forming an exterior surface of the segmental retaining wall;
 - first and second sides that extend from said exterior face to said interior face;
 - a top surface and a bottom surface; and
 - a channel defined by a front wall, a rear wall, and a channel bottom surface and extending across one of said faces and surfaces, *said rear wall including an inwardly extending shoulder.*

11. A retaining system for use in a segmental retaining wall system, said retaining system comprising:
 - a wall block including:
 - an interior face for forming an interior surface of a segmental retaining wall;
 - an exterior face for forming an exterior surface of the segmental retaining wall;
 - first and second sides that extend from said exterior face to said interior face;
 - a top surface and a bottom surface; and
 - retaining means* for retaining a reinforcement member to a retaining wall, said retaining means being *integrally formed in said wall block, said retaining means including an inwardly extending surface.*

Applicant's claims 1 and 11 (emphasis added).

c) **The Rainey Reference**

Rainey discloses a retaining wall comprising wall blocks 14 that include a passageways 30 and lateral alignment slots 32. As explicitly identified in the Rainey disclosure, the alignment slots comprise narrow channels that extend into the block and are adapted to receive an elongated rod 34 during installation of a course of the blocks (*see* column 4, lines 10-14).

d) **Discussion of the Rejection**

As acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837, F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). For reasons discussed below, applicant respectfully asserts that there is no such teaching in the present case.

With regard to independent claim 1, the Office Action alleges that the addition of inwardly extending shoulders to Rainey's "channels" 32 would have been obvious to "assist retention of the retaining bar." As described above, however, the lateral alignment slots 32 are only provided for aligning the blocks in their courses during wall construction. In particular, the slots are merely used to "line up" the blocks in their courses with the elongated rod 34. Therefore, the slots provide no retaining function whatsoever. Because the slots are merely used for initial block alignment, there is no reason to be concerned about retaining the elongated rod in the slots after the wall is

constructed. Accordingly, there would be *no* motivation for a person having ordinary skill in the art to provide inwardly extending shoulders on the slot walls shown in the Rainey patent. For at least this reason, applicant respectfully asserts that the Rainey disclosure cannot render applicant's claims 1-7 and 10 obvious. Accordingly, applicant respectfully requests that the rejection of these claims be withdrawn.

In similar manner, Rainey does not disclose "retaining means for retaining a reinforcement member to a retaining wall, said retaining means being integrally formed in said wall block" as required by claim 11. Although Rainey does provide means for retaining reinforcement members, *i.e.*, tieback rods 50 and anchors 52, these means are *separate* from the block itself. In particular, angle members 44, washers 56, and nuts 58 are used to secure these members in place (*see* Fig. 1). Hence, Rainey does not teach retaining means that are "integrally formed in said wall block". Furthermore, Rainey does not disclose means that include an "inwardly extending surface" as now required by independent claim 11. Therefore, the Rainey disclosure similarly fails to render claims 11-16 obvious and the rejection of these claims should be withdrawn.

2. Rejection of Claim 17

a) Statement of the Rejection

Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Rainey in view of Dawson.

The rejection alleges that Rainey discloses applicant's invention substantially as claimed with the exception of securing a reinforcement member to the retaining bar such that the retaining bar overlaps the reinforcement member. The rejection concludes, however, that in view of the

Dawson disclosure, this feature would have been obvious. Applicant respectfully traverses this rejection.

b) Discussion of the Rejection

As identified above in reference the rejection of independent claim 17 in view of Dawson alone, Dawson does not teach “securing at least one reinforcement member to the wall with a retaining bar that overlaps the reinforcement member within the channel”, but instead teaches inserting pins *through* apertures in a geogrid. Hence, Dawson does not cure this deficiency of the Rainey reference. Moreover, there is *no* motivation to combine the Dawson and Rainey teachings.

As is well established in our patent law, the teachings of separate references can be combined only if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). In this case, the manifestly distinct construction and operation of the Dawson and Rainey systems would destroy any such motivation. Furthermore, even if such motivation existed, it is unclear whether Rainey's and Dawson's teachings could even be combined to result in a viable block or wall design. Therefore, applicant respectfully asserts that the Rainey/Dawson combination cannot render applicant's claim 17 obvious. Accordingly, applicant respectfully requests that the rejection of this claim be withdrawn.

E. Double Patenting Rejections - Obviousness-type

Claims 1-17 have been provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable in view of claims 1-3, 6, and 12-15 of U.S. Patent No. 6,089,793.

Applicant acknowledges, although does not concede to, the Examiner's double patenting rejection. Applicant respectfully submits that the rejection is improper, however, in that U.S. Patent No. 6,089,793, was *withdrawn from issuance* prior to its mistaken publication. A copy of the grant for the request for withdrawal is included herewith.

For this reason, applicant respectfully asserts that no unjustified or improper timewise extension of the "right to exclude" can occur from patenting of applicant's claims relative to the 6,089,793 "patent." Moreover, applicant cannot submit a terminal disclaimer based upon the term of the 6,089,793 "patent" in that there is no such term. For these reasons, applicant respectfully requests that the double patenting rejection be withdrawn.

CONCLUSION



In summary, it is respectfully submitted that claims 1-19 define an invention that embodies a distinct advance in the art not rendered obvious by the cited art of record. Accordingly, an early Notice of Allowability would be appreciated and is therefore respectfully solicited. Should the Examiner have any questions regarding this response, the Examiner is cordially invited to telephone the undersigned attorney.

Respectfully submitted,

David R. Risley
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A handwritten signature in black ink, appearing to read "David R. Risley", is written over a horizontal line. Below the signature, the name "David R. Risley" is printed in a smaller, sans-serif font, followed by "Registration No. 39,395".

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